

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims and the following remarks.

Claim Status

Claims 1-21 are pending in this Application.

Claim 6 has been amended herein, as suggested by the Examiner, to address the 112 Rejection. Otherwise, all of the claims remain as previously presented. Support for the amendment to Claim 6 can be found, for example, at the bottom of page 19.

Prior Art Rejection

Claims 1-3, 5-9 and 11-17 had been rejected as being unpatentable over a combination of Yamada and Machell; Claim 4 had been rejected based on a combination of Yamada, Machell and

Kakinuma; Claim 10 had been rejected as being unpatentable over a combination of Yamada, Machell and Ota; Claim 18 had been rejected as being unpatentable over a combination of Yamada and Machell; and Claims 19-21 had been rejected based on a combination of Yamada, Machell and Goto.

The Examiner's basic position was that Yamada taught all of the aspects of Claims 1 and 18, however, Yamada was lacking in teaching of drawing the film in a conveyance direction. For this limitation, the Examiner turned to Machell which teaches stretching the cellulose ester film in both directions. The Examiner then went on to state that it would be obvious to one of skill in the art to combine the teachings of Yamada and Machell to arrive at the present Invention.

It is Applicants position that such a combination would not arrive at the present Invention and, furthermore, that one of skill in the art would not combine the references for various reasons.

First, the Examiner states that Yamada teaches a zero amount of plasticizer is used in his cellulose ester film. For this, the Examiner points to paragraphs 1 and 10 of Yamada. Yamada, however, doesn't teach if plasticizers should or should not be used. Yamada is silent with respect to plasticizer. He does not teach that no plasticizer is used nor does he teach that plasticizer is used. Rather, Yamada is silent on the use of plasticizers.

Machell specifically teaches that plasticizer is used in his composition. Specifically, he states that 6 to 20% is used and, more preferably, about 8 to 15% based on the weight of the cellulose ester, see column 9, lines 25-29.

Respectfully then, if one were to combine Yamada with Machell, one of skill in the art would add plasticizer in an amount of 6 to 20% in the cellulose ester film. Since Yamada is ambivalent on plasticizers and Machell teaches that 6-20% by weight plasticizer is added, one of skill in the art would add plasticizer in an amount taught by Machell. As noted, Claims 1 and 18, the independent claims upon which all other claims ultimately depend, teach that plasticizers are present in an amount of less than 1 percent. To pick the lack of teaching by

Yamada over the explicit teachings of Machell to arrive at the present Invention, is hindsight.

Thus, it is submitted that the combined teachings of Yamada and Machell result in a film having 6 to 20% by weight plasticizer and not the claimed range of less than 1%.

Second, Applicants submit that it is improper to combine Machell and Yamada because they are directed to different methods for making cellulose ester film. Yamada teaches a solution cast method, see paragraph 50 of Yamada. The solution cast method uses a liquid solution containing cellulose ester film to make the film. In contrast, Machell teaches a melt cast method where no solvent is employed. The Examiner's attention is directed specifically to column 2, lines 8-15, where Machell teaches that his method is the melt cast method and that one the unique aspects of the melt cast method is that it eliminates the need for solvents. Thus, Yamada is teaching a solvent based method wherein Machell is teaching no solvent is present. The two teach away from each other and, thus, it is respectfully submitted that it is improper to combine these two references or, more specifically, that one of skill in the art would not combine the two references because they are at different ends of

the spectrum with respect to how to make cellulose ester films, Yamada is directed to a solution cast method while Machell is directed to the melt cast method.

Finally, it should be noted that neither Yamada nor Machell would lead one of skill in the art to the claimed Invention which has the effect of providing high T_g and low linear expansion coefficient as shown in Table 1 of the Specification. As is apparent from Table 1, Inventive Film No. 103 through 105 contains a plasticizer in an amount of less than 1% and has a high T_g and a low linear expanse of coefficient. This can be compared to Comparative Film No. 106 containing plasticizer in an amount of 1%. A plasticizer in the amount of 1% can be considered close to the teachings of the combined references of Machell and Yamada and, as shown by the evidence in Table 1 and Film No. 106, is far inferior to the present Invention. Specifically, it should be noted that Sample No. 106 has a T_g of 170° and a linear expansion coefficient of 61. Linear coefficient expansion 61 is on the order of twice that of the present Invention, see, for example, Sample No. 104 which has .1% of a plasticizer and has a linear expansion coefficient of 30.

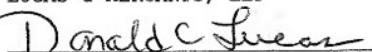
Respectfully, it is improper to combine Machell and Yamada because they are directed to different methods for making cellulose ester film. Furthermore, even if one were to combine the two, one would arrive at a cellulose ester film that has a plasticizer in the amount of 6 to 20% and not less than 1%. Respectfully, the claims, as presented herein, are patentable over the cited references taken alone or in combination.

Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any additional fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account No. 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: 
Donald C. Lucas, Reg. #31,275
Attorney for Applicant(s)
475 Park Avenue South
New York, NY 10016
Tel. 212-661-8000

DCL/mr